

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Toshio SAITO et al.	Examiner:	Davis, D.
Application No.:	10/519,795	Group Art Unit:	2627
Filed:	December 27, 2004		
Attorney Docket No.:	01050_1001		
Client Docket No.:	PCT3008US		

For: METHOD AND APPARATUS FOR DYNAMICALLY ABSORBING
VIBRATION (as amended)

Commissioner for Patents
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicants respectfully request a pre-appeal brief review be made of the present application for at the least the following clear errors.

I. THE OFFICE ACTION OVERLOOKS THE CLAIMED FIRST ELASTIC BODY

For example, claims 1 and 4 recite “a base chassis for holding a motor is mounted on a case of said optical disk device through a first elastic body.” Independent claim 6 recites “a first elastic body disposed between a case of the disk device and a base chassis.”

Applicants respectfully note that the applied reference of *Shishido et al.* does not teach the use of a case, and therefore, cannot disclose the claimed first elastic body. In the final Office Action, it was simply asserted that the chassis 14 of the *Shishido et al.* system is mounted on a case. However, there is no factual support for the use of a case in neither FIG. 1 nor FIG 3 (in fact, nowhere else within *Shishido et al.*). Specifically, FIG. 3 only shows an elastic body 13 that

contacts a weight 12 and a chassis 14; the elastic body does not extend pass the chassis 14.

Shishido et al., within paragraph [0018], states the following (Emphasis Added):

Drawing 3 shows the condition that the elastic body 13 was inserted in and fixed to hole 13B of corner 13A of weight 12. Although it is the metal thing fabricated by press working of sheet metal, die-casting processing, etc., and weight 12 can fabricate an elastic body 13 by rubber, an elastomer, etc., even if it is a metal spring, of course, it is not cared about. In the example of drawing, the example of the elastic body 13 made of rubber is shown, and the elastic body 13 has lobe 13C and lobe 13D and adhesion section 13E. **Crevice 13F between Lobes 13C and 13D are inserted in hole 13B for mounting of weight 12.** Thereby, the elastic body 13 is certainly being fixed so that it may not separate to weight 12. **After adhesion section 13E of an elastic body 13 assembles, it is stuck to it by top-face 14F of a chassis 14.**

As evidenced by the above passage, there is no mention of the elastic body 13 supporting anything beyond the chassis 14, much less supporting a case in the manner claimed.

Moreover, *Shishido et al.* describes a separate mounting/positing technique to an assembly **jig 87, not a case**, acting through pins 41 (not through the elastic body 13), extruding from the jig 87 through positioning holes 14a and 12a in chassis 14 and weight 12, respectively (FIG. 5; paragraph [0021]). Further, coupling to assembly jig 87 can be achieved through holes 72 on chassis 14 (FIG. 1; paragraph [0014]).

Accordingly, there is no support within *Shishido et al.* of **“a base chassis for holding a motor is mounted on a case of said optical disk device through a first elastic body.”**

To the extent the Examiner is relying on the theory of inherency to meet the claimed features, the Examiner is reminded that MPEP §2112 states that the “fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result, or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Also, inherency may not be established by probabilities or possibilities. The

mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberstson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

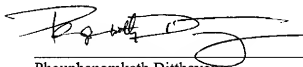
III. CONCLUSION

For the foregoing reasons, the Appeal Brief Panel is respectfully requested to withdraw the rejection of the present application in light of the clear error and allow the pending claims.

Respectfully Submitted,

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11/20/06
Date



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